

member, wherein the sound absorbing structure is without a rear air layer, wherein 25%-compressive hardness of said porous member is 0.5 N/cm^2 or lower, wherein said holes extend through the sound absorbing structure, and wherein a main component of the porous member is made of rubber.

REMARKS

Claims 1-4, 6-15, 17-21, 23-27, 29-34, 36-41, 43 and 49-51 are present in this application. By this Amendment, claims 1, 34, 41 and 51 have been amended, and claims 22, 28, 35, 42 and 44-48 have been canceled. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Claims 1-4, 6, 7, 19-24 and 44-51 were rejected under 35 U.S.C. §102(a) or, in the alternative, under 35 U.S.C. §103(a) over Japanese Patent Publication 10-182865 (JP '865). This rejection is respectfully traversed.

Both of independent claims 1 and 51 recite that 25%-compressive hardness of the porous member is 0.5 N/cm^2 or lower. The resulting advantages of such structure are described in detail in the present application. Without reference to any specific teaching in JP '865, the Office Action broadly concludes that "the porous member of JP '865 meets all the limitations of structure and chemistry." With respect to the compressive-hardness, the Office Action contends simply that this structure is "inherently present" in JP '865.

It has been held that "before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is necessarily present in the reference."

See, for example, *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ2d 1746, 1749-50

(Fed. Cir. 1991). Moreover, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (B.P.A.I. 1990). In the present Office Action, however, the Examiner has not provided any such basis in fact and/or technical reasoning.

Moreover, JP '865 describes the use of resin material "such as polyethylene, polystyrene and polyacryl." These materials are normal neat resins with little elastomeric properties, which suggests the use of materials having hardness characteristics exceeding any limits defined in the claims. A graph showing Young's moduli E_0 of various industrial materials is attached for the Examiner's information and reference. It is apparent that the materials described in JP '865 are generally considerably harder than the materials encompassed by the claimed invention.

In addition to the distinctions noted above, claims 1 and 51 have been amended to recite that a main component of the porous member is made of rubber. The specification describes several varieties of rubber that may be suitable for the present invention at, for example, page 49, lines 2 *et seq.* The resin materials described in JP '865 are not remotely similar to the rubber varieties described in the present specification, and Applicants thus respectfully submit that for this reason also, the rejection is misplaced.

With respect to the dependent claims, Applicants respectfully submit that these claims are allowable at least by virtue of their dependency on an allowable independent claim.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 8-15, 17, 18 and 25-30 were rejected under 35 U.S.C. §103(a) over JP '865 in view of U.S. Patent No. 5,665,943 to D'Antonio. D'Antonio, however, does not correct the deficiencies noted above with respect to JP '865. As a consequence, Applicants submit that these claims are allowable at least by virtue of their dependency on an allowable independent claim. Withdrawal of the rejection is respectfully requested.

Claims 1, 3, 4, 7, 8, 14, 15, 17, 19-22, 25-28, 30-33, 36-40, 43 and 49-51 were rejected under 35 U.S.C. §102(b) or, in the alternative, under 35 U.S.C. §103(a) over U.S. Patent No. 4,128,683 to Nomura et al. This rejection is respectfully traversed.

Like the above-discussed JP '865 publication, the Office Action broadly contends that "the porous member of Nomura meets all the limitations of structure and chemistry," and concludes that the specifically claimed structural characteristics such as compressive-hardness of the member "would be inherently present." Like the above rejection, however, with reference to the noted *Levy* Board decision, the Office Action does not provide any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Moreover, the porous member in the Nomura case is described as being formed of a polyethylene foam. Polyethylene is generally without elastomeric properties and is thus considerably harder than the material of the claimed invention. See the attached chart. Moreover, as discussed above, claims 1 and 51 have been amended to recite that a main component of the porous member is made of rubber. Since this subject matter is lacking in the Nomura patent, Applicants respectfully submit that the rejection is misplaced.

With respect to the dependent claims, Applicants submit that these claims are allowable at least by virtue of their dependency on an allowable independent claim.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 18, 35 and 42 were rejected under 35 U.S.C. §103(a) over Nomura. Applicants respectfully submit, however, that Nomura lacks any suggestion to modify its teaching to correct the deficiencies noted above. As a consequence, Applicants submit that these claims are allowable at least by virtue of their dependency on an allowable independent claim. Withdrawal of the rejection is respectfully requested.

Claims 1, 3, 4, 7, 8, 10, 14, 15, 17, 25-28, 30 and 49-51 were rejected under 35 U.S.C. §102(b) or, in the alternative, under 35 U.S.C. §103(a) over U.S. Patent No. 4,713,277 to Akiyama et al. This rejection is respectfully traversed.

The Office Action again contends that "[t]he porous member of Akiyama meets all the limitations of structure and chemistry," and concludes that specifically claimed structural features of the invention such as compressive-hardness "would be inherently present." Like the above rejections, however, the Office Action fails to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Indeed, the material described in Akiyama is foamed metal such as aluminum, which in fact is considerably harder than the materials of the present invention. See the attached chart. Moreover, claims 1 and 51 recite that a main component of the porous member is made of rubber, which structure is lacking in the Akiyama patent. Applicants thus respectfully submit that the rejection is misplaced.

With respect to the dependent claims. Applicants submit that these claims are allowable at least by virtue of their dependency on an allowable independent claim.

Reconsideration and withdrawal of the rejection are respectfully requested.

Applicants acknowledge with appreciation the indication of allowable subject matter in claims 34 and 41. By this Amendment, these claims have been rewritten in independent form.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the claims are patentable over the art of record and that the application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Prompt passage to issuance is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached pages are captioned "**Version With Markings To Show Changes Made.**"

Respectfully submitted,

NIXON & VANDERHYTE P.C.

By: Alan M. Kagen
Alan M. Kagen
Reg. No. 36,178

AMK:jls
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100
Attachment: Graph

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

1. (Thrice Amended) A sound absorbing structure comprising at least one porous member including a plurality of holes, wherein said holes are at least one kind of through holes, that penetrate through the porous member, and/or non-through holes, that extend into but do not penetrate through the porous member, wherein 25%-compressive hardness of said porous member is 0.5 N/cm^2 or lower, and wherein a main component of the porous member is made of rubber.

34. (Amended) [The] A sound absorbing structure [according to claim 31] comprising at least one porous member including a plurality of holes, wherein said holes are at least one kind of through holes, that penetrate through the porous member, and/or non-through holes, that extend into but do not penetrate through the porous member, wherein 25%-compressive hardness of said porous member is 0.5 N/cm^2 or lower, the sound absorbing structure further comprising a coating film formed on at least a surface of said porous member which is opposite to a sound source wherein said holes penetrates said coating film and said porous member, wherein [the] a main component of said porous member is one of urethane foam and a molded fibrous material.

41. (Amended) [The] A sound absorbing structure [according to claim 37] comprising at least one porous member including a plurality of holes, wherein said holes are at least one kind of through holes, that penetrate through the porous member, and/or non-through holes, that extend into but do not penetrate through the porous member,

wherein 25%-compressive hardness of said porous member is 0.5 N/cm² or lower,
wherein a plurality of porous members are stacked, the sound absorbing structure further
comprising a coating film formed on at least a surface of said porous member which is
opposite to a sound source wherein said holes penetrate said coating film and said porous
member, wherein [the] a main component of said porous member is one of urethane foam
and a molded fibrous material.

51. (Amended) A sound absorbing structure comprising at least one porous member including a plurality of holes, wherein said holes penetrate through the porous member, wherein the sound absorbing structure is without a rear air layer, wherein 25%-compressive hardness of said porous member is 0.5 N/cm² or lower, [and] wherein said holes extend through the sound absorbing structure, and wherein a main component of the porous member is made of rubber.